

**REMARKS**

In the July 11, 2006 Office Action, the Examiner:

- Rejected claims 1-2, 4-5, 7, 10-13, 15-16, and 19-20 under 35 U.S.C. 103(a) as unpatentable over Duckworth Jr. ( U.S. Pat. No. 4,098,427) in view of Erben (U.S. Pat. No. 6,736,353); and
- Rejected claims 3, 6 and 14 under 35 U.S.C. 103(a) as unpatentable over Duckworth Jr.( U.S. Pat. No. 4,098,427) in view of Erben (U.S. Pat. No. 6,736,353) as applied to claims 1 and 13 above, and further in view of Saville et al. (U.S. Pat. No. 5,392,826).

Applicants respectfully disagree that the pending claims are anticipated by the prior art of record. As such, Applicants retain the claims in their current form and respectfully present arguments for their allowability. Therefore, the pending claims remain claims 1-20. The rejected claims contain two independent claims, namely claims 1 and 13.

The Examiner has rejected claims 1-2, 4-5, 7, 10-13, 15-16, and 19-20 under 35 U.S.C. 103(a) as being unpatentable over Duckworth in view of Erben. In particular, the Examiner states that Duckworth discloses a housing (40) comprising an outlet (122) within the housing (40). Duckworth, however, discloses “a disc-like base portion 40” (col. 3, ll. 33-35) and “an annular rim 122” of a “door assembly 84” (col. 3, ll. 24-27). Duckworth certainly does not disclose a housing, let alone an outlet within such a housing.

Erben relates to a “grooved profile for diverting liquid” away from a passenger door of an aircraft, but also does not disclose a housing or an outlet within a housing. For this reason alone, the rejected claims cannot be unpatentable over the combination of Duckworth and Erben.

Furthermore, the Examiner states that Erben discloses an outer surface configured to substantially match an outer contour of an aircraft's skin. The Examiner further states that “[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided an outer surface configured to substantially match an outer contour of an aircraft's skin in order to reduce the air flow resistance during flight operation as taught by Erben (see abstract).”

It is respectfully submitted that a combination of these references is improper for two reasons, namely: (i) Erben is non-analogous art, and (ii) no objective evidence is provided in either of the references to support combining the references.

“Whether a prior art reference is analogous is a question of fact . . . A reference is analogous if it is in the same field of endeavor as the invention . . . Similarity in structure and function of the invention and the prior art is indicative that the prior art is within the inventor’s field of endeavor. *In re Deminski*, 796 F. 2d 436 (Fed. Cir. 1986) . . . If an invention is outside the inventor’s field of endeavor, it is still analogous art if the reference ‘is reasonably pertinent to the particular problem with which the inventor is involved.’ *In re Clay*, 996 F.2d 656, 659 (Fed. Cir. 1992).” *See State Contracting & Engineering Corp. v. Condotte America, Inc.*, 346 F.3d 1057 (Fed. Cir. 2003). In other words, a reference may be pertinent for an obvious argument if (a) it is in the same field of endeavor, or (b) the reference is pertinent to the problem being solved by the inventor. While Duckworth relates to an aircraft lavatory drain port, Erben relates to a passenger door for an aircraft. Other than the fact that both references apply to aircraft, there is no similarity between the references. As such, Erben is clearly outside the Duckworth’s field of endeavor of lavatory drain parts.

Furthermore, the problems faced by Duckworth relate to a jammed locking port, and leaking lavatory fluid in a aircraft lavatory drain port; while the problems faced by Erben relate to liquids dripping onto people passing through a doorway of an aircraft. *See* respective background sections of Duckworth and Erben. As such, neither reference is pertinent to the problem being solved by the inventor of the other reference. In light of the above, one skilled in the art of waste drains would not be motivated to consult the art related to passenger doorways of aircraft. Therefore, it is respectfully submitted that it is improper to combine Erben with Duckworth, as Erben is non-analogous art.

Furthermore, the MPEP requires the Examiner to identify “some objective teaching in the prior art or [show] that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.” *See In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988). “Combining prior art references without evidence of such a suggestion, teaching or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability – the essence of hindsight.” *See In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999) (abrogated on other grounds by *In re Gartside*, 203 F.3d 1305, 1316 (Fed. Cir. 2000)). Thus, the requirement that

the Examiner identify objective evidence of a suggestion or motivation to combine is a critical safeguard against “the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.” *See*, *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). In short, the suggestion to combine references turns on evidence, not the “PTO’s speculation.” *See In re Jones*, 958 F.2d 347, 351 (Fed. Cir. 1992). For this reason, if the Examiner fails to “explain the specific understanding or principle within the knowledge of a skilled artisan that would motivate one with no knowledge of [the present] invention to make the combination,” the Federal Circuit will infer that the Examiner selected these references with the assistance of hindsight. *Rouffet* at 1358 (emphasis added). As such, it is respectfully submitted that the Examiner has failed to provide any evidence of such teaching or suggestion to combine Duckworth with Erben, and, therefore, the rejection of the independent claims should be withdrawn.

With regard to independent claim 13 and dependent claim 2, the Examiner states that “Duckworth also discloses a housing comprises a substantially tubular side wall and a base near one end of the side wall (see figure 1 and 2).” As presented above, Duckworth teaches “a disc-like base portion 40” (col. 3, ll. 33-35) and “an annular rim 122” of a “door assembly 84” (col. 3, ll. 24-27). It is unclear from the Examiner’s rejection what component of Duckworth is being compared to the claimed housing having a tubular side wall. Portion 40, which the Examiner previously identifies as a housing, has a disc-like shape and is not tubular at all. In light of the above, it is respectfully requested that claims 13 and 2 cannot be unpatentable over Duckworth with or without Erben.

Still further, the Examiner states that “[t]he housing further includes waste drain valve components with the housing consisting of a handle (24), a lever (102) a hinge (60), a locking mechanism (70), a spring (1 18), a clasp (22), and fasteners (30).” As Duckworth fails to disclose a housing, it cannot include any of these claimed components within a non-existent housing. Therefore, it is respectfully requested that claims 4 and 19 also cannot be unpatentable over Duckworth with or without Erben.

Finally, the Examiner states that “[t]he housing and the waste drain valve are manufactured as a single unit (see figures 1-3).” Even if Duckworth disclosed a housing, which it does not, Figures 2 and 3 of Duckworth clearly show the components 40, 84, etc., as separate components each having different cross-hatching. Therefore, it is respectfully

submitted that claims 12 and 19 also cannot be unpatentable over Duckworth with or without Erben, as the references clearly fail to teach this limitation.

**CONCLUSION**

In view of the foregoing, it is respectfully submitted that the application is now in a condition for allowance. However, should the Examiner believe that the claims are not in condition for allowance, the Applicant encourages the Examiner to call the undersigned attorney at 650-843-7519 to set up an interview.

If there are any fees or credits due in connection with the filing of this Amendment, including any fees required for an Extension of Time under 37 C.F.R. Section 1.136, authorization is given to charge any necessary fees to our Deposit Account No. 50-0310 (order No. 060950-0089-US). A copy of this sheet is enclosed for such purpose.

Respectfully submitted,

Date: October 23, 2006



45,645

Dion M. Bregman (Reg. No.)  
**MORGAN, LEWIS & BOCKIUS LLP**  
 2 Palo Alto Square  
 3000 El Camino Real, Suite 700  
 Palo Alto, California 94306  
 (650) 843-4000